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| 09/817,515 | 03/26/2001 | Yoichiro Tauchi | 450100-03081 | 7911 |
| 20999 | 7590 | 10/19/2005 | | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER NGUYEN, HUY THANH | |
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| | | | 2616 | |
| DATE MAILED: 10/19/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,515

Applicant(s)

TAUCHI ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 6 and 11 are objected to because of the following informalities: See examiner comment below. Appropriate correction is required.

Claim 6, line 2, after "program" should be inserted -- executed by a computer for performing a method --; and

Claim 6, line 3, "program" should be changed to --method--.

Claim 11, line 1, after "program" should be inserted -- executed by a computer for performing a method --; and

Claim 11, line 6, "program" should be changed to --method--.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1,5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senshu et al (6,658,195) in view Yamada et al (6,115,537).

Regarding claim 1 , Senshu teaches a magnetic tape recording apparatus for recording digital data on a magnetic tape by using a rotary head (columns 3-4, Figs. 2 and 3) comprising:

first acquisition means for acquiring a first group of data including video data. audio data or search data;

second acquisition means for acquiring a second group of data including subcode data related to said first group of data;

synthesizing means for synthesizing data by combining said first group of data and said second group of data so that both groups of data are continuous on the tracks of said magnetic tape without being separated , there is no gap between the audio - video sector and subcode sector (Fig. 3, column 5) and audio and subcode ; and

supply means for supplying the synthesized data to said rotary head so that the synthesized data is recorded on said magnetic tape (Fig. 3) .

Senshu fails to specifically teach that the sync blocks of the main data having header for identifying the type of data.

Yamada teaches a recording apparatus for recording the main data formed by sync blocks having identifying data generating means for generating ID for sync block headers to identify the type of data (Fig. 5D , column 29).

It would have been obvious to one of ordinary skill in the art to modify Senshu with Yamada by using an identifying data generating means as taught by Yamada with the apparatus of Senshu for providing the sync block of the main data of Senshu with header having identifying data to identify the type of data of the main data in order to accurately access the data.

Method claims 5 and 6 correspond to apparatus claim 1. Therefore method claims 5-6 are rejected by the same reason as applied to apparatus claim 1.

Further for claim 6, Senshu further a program stored in a medium for performing the method of claim 6 since the generating video, audio subcode and arranging the data on a track of the tape is controlled by a controller of the apparatus.

4. Claims 1 and 5-6 are rejected under 35 U.S.C. 102 (e) as being anticipated by Oguro (6,026,212) in view of Yamada et al (6,115,537).

Regarding claim 1, Oguro (Fig. 9) teaches a magnetic tape recording apparatus for recording digital data on a magnetic tape by using a rotary head (column 1, lines 15-40, column 8, line 50 to column 9, line 20), comprising:

first acquisition means ((5,9) for acquiring a first group of data including video data, audio data or search data;

second acquisition means (10) acquiring a second group of data including subcode data related to said first group of data;

synthesizing means (8) for synthesizing data by combining said first group of data and said second group of data so that both groups of data are continuous on the

tracks of said magnetic tape without being separated , there is no gap between the audio, video sector and subcode sector (Fig. 1) ; and

supply means for supplying the synthesized data to said rotary head so that the synthesized data is recorded on said magnetic tape (Fig. 9,1).

Oguro fails to specifically teach that the sync blocks of the main data having header for identifying the type of data.

Yamada teaches a recording apparatus for recording the main data formed by sync blocks having identifying data generating means for generating ID for sync block headers to identify the type of data (Fig. 5D , column 29).

It would have been obvious to one of ordinary skill in the art to modify Oguro with Yamada by using a identifying data generating means as taught by Yamada with the apparatus of Oguro for providing the sync block of the main data of Oguro with header having identifying data to identify the type of data of the main data in order to accurately access the data .

Method claims 5 and 6 correspond to apparatus claim 1. Therefore method claims 5 and 6 are rejected by the same reason as applied to apparatus claim 1.

Further for claim 6, Oguro further a program stored in a medium for performing the method of claim 6 since the generating video, audio subcode and arranging the data on a track of the tape is controlled by a controller of the apparatus .

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5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senshu in view of Yamada as applied to claims 1, 5-7 above, further in view of Ohkuma et al (5,574,570).

Regarding claim 2, Senshu fails to teach that the video data is high definition video data and use a compressing means for compressing the high definition video data .

Ohkuma teaches an recording and reproducing apparatus having means for selecting a received high definition video signal or standard definition video signal and compressing the selected video signal by a compressing means and recording the compressed video signal on a tracks of a tape (Figs. 15,21, column 13, lines 15-40, column 17, lines 10-45).

It would have been obvious to o of ordinary skill in the art to modify Senshu with Ohkuma by using a compressing means as taught by Okuma with the apparatus of Senshu for compressing a received high definition and recording high definition video signal or standard definition video signal thereby enhancing the function of the apparatus Senshu .

Regarding claim 4, Senshu as modified with Okuma further teaches a third acquisition means for acquiring compressed standard definition video data (See Ohkuma Figs.14, 15)'wherein the high definition video data acquired by sald first means includes identification information for acquisition identifying the high definition video data as the standard definition video data (See Ohkuma column 13, lines 10-40); and

said synthesizing means select either the high definition video data compressed by said compression means or the standard definition video data acquired by said acquisition means so that combination processing on the selected video data is performed (See Ohkuma Fig. 15 b, column 13, line 40 to column 14line 6).

6. Claims 8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkuma et al (5,574,570) in view of Senshu et al .

Regarding claim 8, Ohkuma discloses a magnetic tape reading apparatus (Figs. 15, 21 and 23) comprising: a rotary head (8)for reading a magnetic tape (9) on which a first group of data including compressed high definition or standard definition video data, audio data, and search data, and a second group of data including subcode data related to said first group of data are continuously recorded on the tracks of said magnetic tape (Fig. 23, column 1, lines 10-25) comprising :

first decompression means (31,32, Fig, 15(b)) for, among the data read from said magnetic tape by said rotary head decompressing the compressed high definition video data;

second decompression means (27,28, Fig. 15b) for among the data read from said magnetic tape by said rotary head, decompressing the compressed standard definition video data;

detection means for, from the data read from said magnetic tape by said rotary head, detecting identification information for identification either the high definition video data or the standard definition video data (column 13, lines 30-40); and

selection means for selectively controlling, based on the result of detection by said detection means, one of said first decompression means and said second decompression means to process the data read from said magnetic tape by said rotary head (column 13, line 50 to column 14, line 6).

Ohkuma fails to teach that the subcode and video or audio is without being separated. Senshu teaches a synthesizing means for synthesizing the video and subcode without being separated (Fig. 3). It would have been obvious to one of ordinary skill in the art to modify Ohkuma with Senshu by using a synthesizing means as taught by Senshu with the apparatus of Ohkuma for processing the video and subcode data without being separated during the recording thereby increasing the useful space of the tape for recording main data.

Method claims 10 and 11 correspond to apparatus claim 8. Therefore method claims 10-11 are rejected by the same reason as applied to apparatus claim 9.

Further for claim 11, Ohkuma as modified with Senshu teaches a medium for storing a program to perform the method of claim 11 since the method of claim 11 is performed under a controller for selecting the high definition video signal or standard definition to be decoded and processed for reproducing the video signal.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkuma in view of Senshu as applied to claim 8 above, and further in view of Lee (5,940,016).

Regarding claim 9, Ohkuma fails to teach using MP@HL or MP@H-14 in the MPEG for decoding the reproduced video signal.

Lee teaches using MP@HL or MP@H-14 in the MPEG system for decoding a reproduced compressed MPEG video signal (column 6 lines 7-25). It would have been obvious to one of ordinary skill in the art to modify Ohkuma with Lee for using MP@HL or MP@H-14 in the MPEG system as an alternative method for decoding the reproduced video signal when the video signal is compressed by MPEG system.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Senshu et al in view of Ohkuma et al as applied to claim 2 above, and further in view of Lee (5,940,016).

Regarding claim 3, Senshu fails to teach using MP@HL or MP@H-14 in the MPEG for decoding the reproduced video signal.

Lee teaches using MP@HL or MP@H-14 in the MPEG system for decoding a reproduced compressed MPEG video signal (column 6, lines 7-25). It would have been obvious to one of ordinary skill in the art to modify Ohkuma with Lee for using MP@HL or MP@H-14 in the MPEG system as an alternative method for decoding the reproduced video signal when the video signal is compressed by MPEG system.

9. Claims 1,5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanota et al (5,426,538) in view of Yamada et al (6,115,537).

Regarding claims 1 and 7, Kanota teaches a magnetic tape recording apparatus for recording digital data on a magnetic tape by using a rotary head (Fig. 1 and 2),(columns 3-4, Figs. 2 and 3) comprising:

first acquisition means for acquiring a first group of data including video data.
audio data or search data;

second acquisition means for acquiring a second group of data including
subcode data related to said first group of data;

synthesizing means for synthesizing data by combining said first group of data
and said second group of data so that both groups of data are continuous on the tracks
; and

supply means for supplying the synthesized data to said rotary head so that the
synthesized data is recorded on said magnetic tape (Fig. 3) .

Kanota further teaches that separated audio data areas can merge into a single
area without any space therebetween (column 8, lines 30-46) but fails teach that the
video data and subcode data are synthesized with out space therebetween. However, it
is noted that eliminating a part and its function is obvious to one of ordinary skill in the
art (See Elimination of an element and its function---*In re Karlson*, 153 USPQ 184
(CCPA 1963). Therefore, it would have bee obvious to on of ordinary skill in the art to
modify Kanota by using the teaching of Kanota for eliminating means for generating
space between video data, audio at and subcode data of the apparatus of Kanota to
provide the subcode data and video data without any space therebetween .

Kanota fails to specifically teach that the sync bocks of the main data having
header for identifying the type of data.

Yamada teaches a recording apparatus for recording the main data formed by sync blocks having identifying data generating means for generating ID for sync block headers to identify the type of data (Fig. 5D, column 29).

It would have been obvious to one of ordinary skill in the art to modify Kanota with Yamada by using a identifying data generating means as taught by Yamada with the apparatus of Kanota for providing the sync block of the main data of Kanota with header having identifying data to identify the type of data of the main data in order to accurately access the data.

Therefore method claims 5 and 6 are rejected by the same reason as applied to apparatus claim 1.

Further for claim 6, Kanota further teaches a program stored on a medium for performing the method of claim 6 since generating video, audio subcode and arranging the data on a track of the tape is controlled by a controller of the apparatus.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 and 5-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 9-10 of U.S. Patent No. 09/824,959. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1 and 5-6 of the present application and claims 7 and 9-10 of U.S. Patent No. 09/824,959 is that claims 7 and 9-10 further recites track information that is not found in claims 1 and 5-6 of the present application. However, it is noted that eliminating a part is obvious in view of a practitioner in the art. See *Elimination of an element and its function---In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 7 and 9-10 of U.S. Patent No. 09/824,959 by eliminating means for generating track information from claims 7 and 9-10 of U.S. Patent No. 09/824,959 to provide claims 1 and 5-6 of the present application.

Response to Arguments

12. Applicant's arguments filed 25 July 2005 have been fully considered but they are not persuasive.

Applicant argues that Senshu is not a prior art since the filing date of Senshu is after the present application priority paper. In response, it is noted that an English translation for the priority paper has not been filed by applicants.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY NGUYEN
PRIMARY EXAMINER